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| APPLICATION NO.            | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 10/748,449                 | 12/30/2003  | Richard D. Keeven    | 1671-0281           | 2371             |
| 28078                      | 7590        | 08/18/2010           |                     |                  |
| MAGINOT, MOORE & BECK, LLP |             |                      | EXAMINER            |                  |
| CHASE TOWER                |             |                      | WOODALL, NICHOLAS W |                  |
| 111 MONUMENT CIRCLE        |             |                      | ART UNIT            | PAPER NUMBER     |
| SUITE 3250                 |             |                      |                     | 3775             |
| INDIANAPOLIS, IN 46204     |             |                      |                     |                  |
|                            |             | MAIL DATE            | DELIVERY MODE       |                  |
|                            |             | 08/18/2010           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                     |                     |
|------------------------------|-------------------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>              | <b>Applicant(s)</b> |
|                              | 10/748,449                          | KEEVEN ET AL.       |
|                              | <b>Examiner</b><br>Nicholas Woodall | Art Unit<br>3775    |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on **24 May 2010**.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) **17-43** is/are pending in the application.  
 4a) Of the above claim(s) **17-23** is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) **24-34 and 36-43** is/are rejected.  
 7) Claim(s) **35** is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/US/06)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the Appeal Brief filed on March 1<sup>st</sup>. 2010, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

***Allowable Subject Matter***

2. The indicated allowability of claim 36 is withdrawn in view of the newly discovered reference(s) to Ferrante (U.S. Patent 5,275,603). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 23, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufman (U.S. Patent 4,721,104).

Kaufman discloses a device comprising an instrument, an augment (5), and a femoral resection guide (60). The instrument includes a positioning member (61) defining a femur facing side and a planar tibia facing side. The positioning member includes a first coupler (65) and a connector member comprising a first mating feature (a bore receiving or created by screw 62; column 5 lines 1-7). The augment includes an upper surface, a contoured lower surface, and a second coupler (92) that cooperates with the coupler to fix the augment to the positioning member, wherein the upper surface of the augment abuts the tibia facing side of the positioning member. The femoral resection guide includes a second mating feature (62) that mates with the first mating feature.

5. Claims 24, 27, 28, 31-34, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferrante (U.S. Patent 5,275,603).

Ferrante discloses a device comprising a device comprising an instrument comprising a positioning member (26), an augment (31) comprising a pin, a femoral resection guide (44, 46, etc.), an intramedullary pin (78) received within a guide slot (28 and 29) of the positioning member, and a handle (32) extending from the positioning member. The positioning member defines a side capable of facing a femur and a planar side capable of facing a tibia and includes a bore (30) that receives the pin of the augment and a connector member (14) having a first mating feature (42). The femoral resection guide

includes a second mating feature that mates with the first mating feature (column 3 lines 29-31). The augment includes an upper surface (the top surface of the pin) that abuts the side capable of facing a tibia when the augment is fixed to the positioning member and a lower surface contoured to fit within the bore of the positioning member.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 25, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrante (U.S. Patent 5,275,603) in view of Vito (U.S. Patent 5,931,838).

Ferrante discloses the invention as claimed except for the bore further comprising an internal groove with a resilient O-ring and the pin being frictionally engaged with the O-ring. Vito teaches a device comprising a bore further comprising an internal groove with a resilient O-ring that frictionally engages a pin in order to improve the fixation between a device and a bone. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Ferrante wherein the bore further comprises an internal groove with a resilient O-ring frictionally engaged with the pin in view of Vito in order to improve the fixation between the device and a bone.

8. Claims 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrante (U.S. Patent 5,275,603) in view of Vito (U.S. Patent 5,931,838).

Ferrante discloses a device comprising an instrument comprising a positioning member (26), an augment (31) comprising a pin, a femoral resection guide (44, 46, etc.), an intramedullary pin (78) received within a guide slot (28 and 29) of the positioning member, and a handle (32) extending from the positioning member. The positioning member defines a side capable of facing a femur and a planar side capable of facing a tibia and includes a bore (30) that receives the pin of the augment and a connector member (14) having a first mating feature (42). The femoral resection guide includes a second mating feature that mates with the first mating feature (column 3 lines 29-31). The augment includes an upper surface (the top surface of the pin) that abuts the side capable of facing a tibia when the augment is fixed to the positioning member and a lower surface contoured to fit within the bore of the positioning member. Ferrante fails to disclose the bore further comprising an internal groove with a resilient O-ring and the pin being frictionally engaged with the O-ring. Vito teaches a device comprising a bore further comprising an internal groove with a resilient O-ring that frictionally engages a pin in order to improve the fixation between a device and a bone. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Ferrante wherein the bore further comprises an internal groove with a resilient O-ring frictionally engaged with the pin in view of Vito in order to improve the fixation between the device and a bone.

***Allowable Subject Matter***

9. Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments, see pages 23-31, filed May 24<sup>th</sup>, 2010, with respect to the rejection(s) of claim(s) 25-27 and 37-40 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly cited Ferrante reference as discussed above.

11. Applicant's arguments, see page 16-22 and 31-34, filed May 24<sup>th</sup>, 2010, with respect to the rejection(s) of claim(s) 28-32 and 41-43 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly cited Ferrante reference as discussed above.

12. Applicant's arguments filed May 24<sup>th</sup>, 2010 directed to the rejection of claims 24, 33, and 34 under 35 U.S.C. 102(b) in view of Kaufman have been fully considered but they are not persuasive. The applicant argues that Kaufman does not disclose an "augment" under the plain meaning of the term augment. The applicant argues that an "augment" would be something that is used on an "as needed" basis to increase the size, amount, degree, or severity of something else (see page 11 lines 13-22 of the appeal brief filed on May 24<sup>th</sup>, 2010). First, an augmentation is not necessarily used in

an "as needed" basis. For example, knee prosthesis can be used to augment a bad knee joint to strengthen and increase the patient's mobility, where the knee prosthesis is a permanent augmentation to the patient. Second, the applicant did not provide a specific meaning for the term "augment" therefore the examiner must use the broadest most reasonable interpretation of the term without reading any limitations from the specification into the claims. The specification describes the "augment" as a piece of an instrument that may be added to allow the device to better perform the device's intended function, i.e. the "augment" of the invention is a spacer added to a positioning device to help the device better position to better position the knee. However, these limitations directed to the intended use of the "augment" with the positioning member are not in the claims and the limitations cannot be read into the claims from the specification. Furthermore, an element cannot be claimed in an "as needed" basis. If an element is in the claim language then the element is required for the claimed invention and the prior art does not need to disclose an element that is used "as needed". Since there are no limitations directed to how the "augment" adds to or interacts with the positioning member to better perform the device's intended use in the claims the examiner only needs to find a prior art reference that discloses an element that reads upon the structural limitations of the "augment" as presented in the claims. Therefore, the trial element (5) of the Kaufman device reads upon the limitations of an "augment" as presented in the claims.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
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